

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 3 for example, the phrases "book- like" and "paper-like" renders the claim(s) indefinite because it is not clear what structures are included/excluded from the phrase book-**like** or paper-**like**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-9,16-17,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,808,792 to Weber in view of 6,213,702 to Wesselink.

Weber discloses an individualized security document (passport, substate 8 and column 1 lines 31-33 and column 2 lines 20-21 discloses the substate being a passport) having a transfer film (figure 2) which is provided with security elements and which has a base film (3) and a decorative layer arrangement (12,19) having the security elements

(36), the decorative layer arrangement having an adhesive 15 on the side remote from the base film. Weber also discloses in column 7 lines 39-44 that the transfer film element (17) be of a size that is the same as the size of the substrate (page of the passport).

Weber does not however disclose the security document (passport) having a number of pages joined together by means of a fixing or adhesive.

Wesselink teaches having a security document (passport) having a number of pages included transfer laminate 1 joined by a common fixing (sewing along line AB, see figures 1-2 of Wesselink).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pages and binding or fixing of Wesselink with the passport of Weber for the purpose of securing various amounts of information together in the passport.

Regarding claim 2, Weber modified by Wesselink discloses the transfer film provided with security elements is transparent column 3 line 42 of Weber).

Regarding claim 3, Weber modified by Wesselink discloses the transfer film comprises paper (column 7 lines 48 and 55 of Weber).

Regarding claim 4, Weber modified by Wesselink discloses the decorative layer (7 of Weber) having security elements is temporarily connected by means of a release layer (9 of Weber) to a carrier film (5 of Weber) which is permanently connected to the base film (3 of Weber) by means of permanent adhesive (4 of Weber).

Regarding claim 6, Weber modified by Wesselink discloses the decorative layer arrangement is applied in the form of a label to the base film or the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 7, Weber modified by Wesselink discloses the decorative layer arrangement is laminated onto the base film or onto the carrier film which is permanently connected to the base film (figure 2-3 of Weber).

Regarding claim 8, Weber modified by Wesselink discloses the decorative layer arrangement is transparent or partially transparent (column 3 line 42 of Weber).

Regarding claim 9, Weber modified by Wesselink discloses the base film and/or carrier film provided with position markings (perforations 16 are being considered the position markings).

Regarding claim 16, Weber modified by Wesselink discloses the transfer film provided with security elements is of surface dimensions adapted to a page of the security document (column 7 lines 39-44 of Weber).

Regarding claim 17, wherein the transfer film is provided with security elements of surface dimensions adapted to a double page of the security document. It would have been an obvious matter of design choice to size the transfer film as claimed since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Wesselink and further in view of 5,103,583 to VanErmen.

Weber modified by Vegmeulen discloses most elements of the claims but for the base film having a window or opening.

VanErmen teaches having a label system having a base film (backing 12) with a window. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the window of VanErmen with the base film of Weber modified by Wesselink for the purpose of viewing indicia or allowing for the addition of indicia on the underlying surface. It is noted that Weber discloses the transfer film as being label-like in its arrangement (column 6 lines 28-31 and column 7 lines 36-44 of Weber), therefore the combination with VanErmen would have been obvious to one having ordinary skill in the art.

Regarding claim 21, see rejection of claim 1 above.

Claims 10-15,18-20,22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Wesselink and further in view of 4,533,160 to Malone.

Weber discloses that the transfer film is sized to be the same as the substrate (page of a passport- column 7 lines 39-44, this transfer film therefore essentially forms a sheet) and Wesselink teaches having a passport book with multiple sheets and stitching to combine the sheets.

Weber modified by Wesselink does not however disclose the base film is provided with a perforation.

Malone discloses a book having layered sheets that are separated via perforations (24). In that the base film is part of the sheet bound in the book as taught by Weber modified by Wesselink, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the perforations as taught by Malone with the sheet of Weber modified by Vegmeulen for the purpose for allowing for removal from the book.

Regarding claims 11-14, Weber modified by Wesselink and Malone discloses perforations in layered sheets. Regarding the specific arrangement of the perforations, in that it is known to have perforations to separate the wanted portions of a sheet (or layers thereof) it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the position of the perforation as a matter of design choice. Additionally, the positioning of the perforation would have been obvious because applying a particular known technique to improve similar devices in the same way is recognized as part of ordinary capabilities of one skilled in the art.

Regarding claim 15, in that the base film of Weber modified by Wesselink and Malone comprises paper it is inherently capable of supporting security features. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include security features on the base film as suited for the intended use.

Regarding claims 18-19,22-23, see rejection of claim 10 above, see also figure 1 of Malone which illustrates a portion of the sheet 20 that remains with the booklet when torn along perforation 24).

Regarding claims 20,24 see rejection of claim 12 above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The objection to the drawings from the previous action has been overcome by amendment.

Wesselink is being introduced in this action to address the concept of having a common binding (stitch) between the transfer film and sheets of the booklet or passport document.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/J. W./
Examiner, Art Unit 3725

/Derris H Banks/
Supervisory Patent Examiner, Art
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